



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,619	03/10/2000	Peter Post	P00.0364	5081

7590 01/13/2003

SCHIFF HARDIN & WAITE
Patent Department
6600 Sears Tower
Chicago, IL 60606-6473

EXAMINER

VIG, NARESH

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/522,619

Applicant(s)

POST ET AL.

Examin r

Naresh Vig

Art Unit

3629

-- The MAILING DATE of this communicati n appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 - 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This is in reference to response received on 17 October 2002 to the office action mailed on 31 July 2002. Amendment of claim 1 is acknowledged. Cancellation of claims 2, 10 – 16 are acknowledged. There are 8 claims 1, 3 – 9 pending for examination.

Claim Objections

Claim 1 is objected to because of the following informalities: Claim 1, line 14 recites “following at least one of proper u se and proper replacement”. Examiner reads the claim as “following at least one of proper use and proper replacement”. The word “use” is misspelled as “u se”. Appropriate correction is required.

Response to Arguments

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

Art Unit: 3629

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, French reference discloses that the security device can be programmed (i.e. security can be changed).

Also, it is obvious that the French Security module has the security code programmed prior to inserting it in a module.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 are rejected under 35 USC 103(a) as being unpatentable over French US Patent 5,548,163 in view of Emmett et al. US Patent 6,019,281 hereinafter known as Emmett.

Regarding claim 1, French discloses a security device for use with audio and video equipment installed in an automobile or other type of vehicle, such as a van or boat. The security device includes a module which is coupled to the equipment to be protected. The security device comprises an encoded security key which is plugged into a key receptacle to disarm and arm the module. The key includes logic for producing an

Art Unit: 3629

encoded disarming signal and is of a size which can be easily carried on the person of the user. The module can be located at a space in the vehicle which is remote to the key receptacle thereby allowing otherwise inaccessible equipment to be conveniently secured from the passenger compartment of the vehicle for example. Without a proper encoded key, the equipment cannot be operated and is virtually useless if removed from the vehicle. To provide a further deterrent to theft the module and/or equipment include a warning notice signifying the inoperative nature of the equipment without the key. The "disarming" process is started by the user inserting the key 24 into the key receptacle 26 for at least 2 seconds. After about 2 seconds, the user removes the key to use the ignition key, and, the user has ten seconds to activate the ignition switch, otherwise, the disarming procedure must be started again. (col. 10, lines 53 – 64)

French discloses that the switches allow for the programmability of the respective voltage limits for the first and second window comparators. The switches can be conveniently implemented using a known "4-pole" DIP switch (not shown). Furthermore, the RC networks and the pwm resistors R.sub.2, R.sub.3 in the key 24 (FIG. 2) provide additional flexibility for producing many unique encoded keys and security modules (security modules with different encoded keys). In addition, the pwm modulators provide a level of complexity which makes the reverse engineering of a key even more difficult (col. 7, lines 25 – 36).

French does not disclose erasing the security relevant data. However, French discloses that the security device establishes an "anti-theft" or "armed" condition whenever the amplifier is disconnected from the power feed. Removal of power causes

Art Unit: 3629

the SCR to unlatch and the amplifier will be disabled (as described above). Therefore, whenever the equipment has been disconnected from the +12 V power connection, the key must be plugged in to remove the "anti-theft" condition and thereby enable operation of the amplifier (col. 12, lines 22 – 31). Emmett discloses that its Postal Security Device (PSD) may be implemented as a cartridge that can be inserted into and removed from the host system. It simplifies meeting requirement for the PSD enclosure to detect any tampering at the time the tampering occurs and to immediately erase all memory contents that are cryptographically important". (col. 1, line 60 – col. 2, line 10). Therefore, it is known at the time of applicant's invention to a person with ordinary skill in the art to erase security relevant data of the device to disable the device and further limiting its usage.

French discloses that "with the 2-second delay feature described above (in col. 10, lines 42 – 52), operation of the security device 10 is as follows. The "disarming" process is started by the user inserting the key 24 into the key receptacle 26 for at least 2 seconds. The 2-second time constant is determined by the values for resistor R.sub.5 and capacitor C.sub.1 in the RC network 113. After about 2 seconds, the user removes the key 24 (in order to use the ignition key (not shown)) and the user has ten seconds to activate the ignition switch 39, otherwise, the disarming procedure must be started again." (col. 10, lines 53 – 64)

Regarding claim 3, French discloses that its security module includes a power input port. The power input port is used to provide power to the security module and includes an input coupled to the constant +12 volt power feed which provides a supply rail +12 V for powering the circuit elements. The power input port includes an input which is connected to car ground and provides a reference or ground rail for the security module (col. 6, lines 22 – 33). French does not disclose having internal battery. Emmett discloses that when the PSD is connected to a host and is active, the circuitry preferably powered from the host, and the PSD display circuitry may be powered from the host or from its own power source. Therefore, it is known at the time of applicant's invention to a person with ordinary skills in the art to include battery in French to make the security device self powered for keeping the circuitry alive when there is a power failure (for example, alarm clocks have alternate battery power to keep the clock working when there is a power failure).

French does not disclose monitoring battery. Emmett discloses that PSDs may be implemented as a cartridge that can be inserted into and removed from the host system. Emmett PSD enclosure meets requirements to detect any tampering at the time the tampering occurs and to immediately erase all memory contents that are cryptographically important. "This almost certainly implies using long lived battery-powered detection and erasing circuits, including a 'self destruct' mode for when battery failure is near." (col. 1, line 60 – col.2, line 10). Therefore, it is known at the time of applicant's invention to a person with ordinary skills in the art to monitor battery status to determine time to replace the battery, and also to detect why the circuitry is not working

Art Unit: 3629

(for example, Laptop computers are known to monitor status of the battery to determine when to automatically put the system in hibernation mode (just keeping the memory alive) to protect user's recent work).

Claims 4 and 5 are rejected under 35 USC 103(a) as being unpatentable over French US Patent 5,548,163 in view of Emmett et al. US Patent 6,019,281 hereinafter known as Emmett and in further view of Gerst US Patent 4,217,484

Regarding claims 4 and 5, neither French nor Emmett disclose inhibiting the security module when there is damage to the security module. Gerst discloses a taximeter with logic circuitry that provides passenger detection, distance measuring, clock timing, speed referencing, tamper and fault detectors, manual pushbutton controls, settable constants for distance, time and money, and an emergency power supply. Logic circuitry is interconnected to provide a taximeter that accurately computes and displays taxi fares, adds extras charges manually or automatically, displays extras charged on the meter face, detects tampering and circuit faults automatically, displays a tamper number on the meter fare display that indicates the specific tamper or fault, displays meter operation on the taxi toplight, including tampering, disables the taximeter from operation in the event of a tamper or fault, can be reset to normal operation only by an external coded reset device, counts and displays taxi driveshaft rotations on the fare

display under the command of an external calibration device, and provides positive notice to the taxi owner in the event of any tampering to the taximeter system (abstract). Whenever the meter is disabled because of a fault or tamper, it becomes necessary to perform a code match reset to restore normal meter operations. If a driver were to tamper with the meter in an attempt to disable its automatic operations, the meter would lock up in the tampered state. The driver would be forced to return to his company in the tampered state which would be detected immediately by the management. (col. 10, lines 15 – 60). Therefore, it is known at the time of applicant's invention to a person with ordinary skills in the art to inhibit the security module when there is damage to the security module to prevent losses by the use of damaged device.

Claims 6 – 9 are rejected under 35 USC 103(a) as being unpatentable over French US Patent 5,548,163 in view of Emmett et al. US Patent 6,019,281 hereinafter known as Emmett and SNA Architecture from IBM Corporation.

Regarding claims 6 – 9, neither French nor Emmett disclose communicating status before the expiration of pre-determined time. However, it is notoriously known at the time of applicant's invention to a person with ordinary skills in the art that computer networks like SDLC protocol in IBM SNA architecture, remote devices (PU2, PU2.1) provide status to controller (PU4). In the event when the controller does not receive

Art Unit: 3629

response from the remote devices after pre-determined time (time interval between each poll, claim 8) and tries (number of times to poll the remote device before it is put on inactive state, claim 9), the controller puts the remote device in an inactive state. Remote device is put in an inactive state. When the controller receives valid response from the remote host, remote device is put in active state (restoring normal operation). Therefore, it would have been obvious to a person with ordinary skills in the art to communicate status to the remote within pre-determined time to monitor remote devices from a central location.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

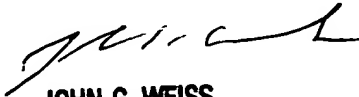
1. SNA and LU6.2 Connectivity
2. Information on batteries used in computers

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

January 7, 2003


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600